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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,783	12/30/1999	DONALD K. NEWELL	P6929/1020P6929	2707
57035 7590 01/03/2012 KACVINSKY DAISAK PLLC C/O CPA Global P.O. BOX 52050 MINNEAPOLIS, MN 55402				
EXAMINER SHANG, ANNAN Q				
ART UNIT 2424		PAPER NUMBER		
NOTIFICATION DATE 01/03/2012		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sbartl@kdfirm.com

Office Action Summary**Application No.**

09/474,783

Applicant(s)

NEWELL ET AL.

Examiner

ANNAN SHANG

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1, 4-7 and 12-25 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1, 4-7 and 12-25 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. Request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/2011 has been entered.

Response to Arguments

2 Applicant's arguments with respect to claims 1, 4-7 and 12-25 have been considered but are moot in view of the new ground(s) of rejection, i.e., **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247)**.

With respect to the rejection of the last office action, Applicant amends claims, discusses the prior arts of record and further argues that the prior art of record do not meet the amended claims limitation (see page 7+ of Applicant's Remarks).

In response, Examiner disagrees, as discussed in the office action **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247)**, meet the amended claims limitations.

Gotwald permits the Client to **purchased various services and provides security to data by encrypting the data including assigning conditions to the data,** but silent as to **assigning other conditions** such: as a descriptor to indicate whether the storage device may store the received BC prior to viewing and without reproducing the received BC, storing the broadcast content and a number of times the playback device may reproduce the received broadcast content and **the storage device operable by the receiver to store the received broadcast content without requiring payment for the received broadcast content unless and until the received broadcast content is retrieved from the storage device and consumed on the playback device.**

However, **Horton** teaches broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify Gotwald with the ability to specify the action as storing the content and embedding descriptor information in order for the broadcast provider to specify what could be done to the broadcast programs to prevent unauthorized copying and also allow the user to only access certain programs. Gotwald as modified by Horton, fails to explicitly teach controlling the number of times that the BC may reproduce the stored BC, maintaining information relating to the use or duration of use of the received BC through the playback device for remuneration of a provider of the BC. However, **Russo** discloses a system where **a storage device of a receiver,**

stores the received broadcast content without requiring payment for the received broadcast content unless and until the received broadcast content is retrieved from the storage device and consumed on the playback device and further discloses a descriptor or supplemental information with the BC, where a receiver-controller, manages playbacks of stored BC, including duration (time, days, week, etc..) of use, monitors various user activities as to the use of the BC, controlling billing and payment for remuneration of a provider of the BC (col.4 line 45-col.5 line 47, col.6 lines 34-55, col.8 lines 65-67 and col.9 line 1+). Hence it would have been obvious to one of ordinary skill in the art at the time the invention to incorporate the teaching of Russo into the system of Gotwald as modified by Horton to **store contents on a storage device at the user location and further manage the reproduction of the stored BC for fees and royalties to the service provider and furthermore, permit only authorized user. Hence the amendments do not overcome the prior art of record. This office action is non-final.**

Claim Rejections - 35 USC § 103

3. following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. ims 1, 4-7 and 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gotwald (5,987,518)** in view of **Horton et al (4,945,563)** and further in view of **Russo (5,619,247)**.

With respect to Claims 1 and 4-6, **Gotwald** teaches a system for controlling use of broadcast content (BC) comprising:

A receiver (Client 18) in communications with a source of broadcast content (Server 12) and a playback device and a storage device, the receiver comprising a data interface having an Internet Protocol (IP) data module to process a pay-per-use IP TV broadcast stream comprising IP encapsulated data, the receiver to control the use of received BC through the playback device and the storage device in accordance with a descriptor embedded in the received BC (col.3, line 26-col.4, line 32 and line 55-col.5, line 41).

Gotwald permits the Client to **purchased various services and provides security to data by encrypting the data including assigning conditions to the data**, but silent as to **assigning other conditions** such: as a descriptor to indicate whether the storage device may store the received BC prior to viewing and without reproducing the received BC, storing the broadcast content and a number of times the playback device may reproduce the received broadcast content and **the storage device operable by the receiver to store the received broadcast content without requiring payment for the received broadcast content unless and until the received broadcast content is retrieved from the storage device and consumed on the playback device.**

However, **Horton** teaches broadcasting audiovisual content along with embedded descriptor information to define an action to be taken pertaining to the received content, explicitly storing the received broadcast content (col.3 lines 38-67).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify Gotwald with the ability to specify the action as storing the content and embedding descriptor information in order for the broadcast provider to specify what could be done to the broadcast programs to prevent unauthorized copying and also allow the user to only access certain programs. Gotwald as modified by Horton, fails to explicitly teach controlling the number of times that the BC may reproduce the stored BC, maintaining information relating to the use or duration of use of the received BC through the playback device for remuneration of a provider of the BC.

However, **Russo** discloses a system where **a storage device of a receiver, stores the received broadcast content without requiring payment for the received broadcast content unless and until the received broadcast content is retrieved from the storage device and consumed on the playback device and further discloses** a descriptor or supplemental information with the BC, where a receiver-controller, manages playbacks of stored BC, including duration (time, days, week, etc.,) of use, monitors various user activities as to the use of the BC, controlling billing and payment for remuneration of a provider of the BC (col.4 line 45-col.5 line 47, col.6 lines 34-55, col.8 lines 65-67 and col.9 line 1+).

Hence it would have been obvious to one of ordinary skill in the art at the time the invention to incorporate the teaching of Russo into the system of Gotwald as modified by Horton to **store contents on a storage device at the user location and further manage the reproduction of the stored BC for fees and royalties to the service provider and furthermore, permit only authorized user..**

As to claim 7, the claimed "method comprising..." is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

Claims 12-15 are met as previously discussed with respect to claims 1 and 4-6.

As to claims 16-18, Gotwald further discloses obtaining payment information from the user of the received broadcast content, communicating consumption information to a billing facility at the service provider of the BC (col.4, line 49-col.5, line 6).

As to claim 19, the claimed "a machine-readable medium... a method comprising..." is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

As to claim 20, Gotwald further discloses where the storage comprises a memory accessible by a computer (col.3, line 51-col.4, line 7).

As to claim 21, Gotwald as modified by Horton and Russo, fail to show that the storage medium comprises a portable storage device. However, Official Notice is taken that it is well known and expected in the art to use removable storage devices, such as CD-ROMS or removable hard drives.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention to modify the system of Gotwald as modified by Horton and Russo with a portable storage device so that the instructions could be transported to other systems.

As to claims 22-25, the claimed "A system comprising a receiver in communication with a source of broadcast content..." is composed of the same structural elements that were discussed in the rejection of claims 1 and 4-6.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ANNAN SHANG** whose telephone number is **(571)272-7355**. The examiner can normally be reached on **7:00am-4:00pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Pankaj Kumar** can be reached on **571-272-3011**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. **If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.**

/Annan Q Shang/
Primary Examiner, Art Unit 2424

Annan Q. Shang